| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/354,161 | 07/16/1999 | ALAIN PENDERS | Q55099 | 4708 |

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| EXAMINER |
|---|
| ARANI, TAGHI T |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2131 | 12 |

DATE MAILED: 05/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 09/354,161 | PENDERS, ALAIN |
| | **Examiner** | **Art Unit** | |
| | Taghi T. Arani | 2131 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *12 February 2004*.

2a)☒ This action is **FINAL.**    2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-14* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *4-6* is/are allowed.

6)☐ Claim(s) *1-3, 7-11* is/are rejected.

7)☐ Claim(s) *12-14* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

## DETAILED ACTION

**Claims 1-11 were pending for examination.**

**Claims 12-14 are newly added.**

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act

of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act

of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an

international application filed before November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA

35 U.S.C. 102(e)).

Claims 1-3,7-11 are rejected under 35 U.S.C. 102(e) as being anticipated by prior art of

record , Apperson et al, U.S. Pat. No. 5,978,484.

**As per (Amended) claims 1, 9-11,** Apperson is directed to a system and method for

distributing and executing an executable code wherein before sending executable codes to a

client (i.e. a terminal) , a distributing authority (i.e. a service provider) associates a privilege.

request code (i.e. predefined functionality) with the executable code, see abstract. The privilege

request code indicates a requested set of privileges that the executable code will potentially exercise during execution.

Apperson teaches that the distributing authority digitally sign s the executable code and the privilege request code, and also provides a certificate that can be traced by the client to a known certifying authority (CA), see col. 2, lines 40-53.

Apperson further teaches that each certificate indicated an authorized set of privileges that the holder of certificate is authorized pass on to lower members of the hierarchy and that when a distributing authority distributes actual executable code, the associated privilege request code must indicate a subset of the privileges indicated by the privilege authorization code of the certificate held by the distributing authority, see col. 2, lines 61-67. That is to say, the distributed executable code (or predefined functionality) is part of the privileges indicated and held by the privilege authorization code (i.e. global functionality).

**As per (Amended) claim 2**, Apperson teaches that the structure of hierarchy resembles a tree structure (tree-like) with a "root" member at the top connected to lower "leaf" members by "branch".

Apperson further teaches that the root Ca has authority over all possible privileges that an executable object might potentially exercise and that beneath the root are plurality of distributing authorities to distribute code with a particular privilege request code, see col. 5, lines 36-67.

Apperson further teaches that when a client computer (i.e. a terminal T) receives an executable object from a distributing authority DA3, the executable object is signed by DA3 and that the distributing authority DA3 receives its privilege authorization code from a certifying authority CA2. DA3's privilege authorization code is a subset of CA2's privilege authorization

code. The CA1's receives its privilege authorization code from the root certifying authority

which has all possible privileges that might be exercised by executable objects, see col. 6, lines

16-29, see also Fig. 3.

**As per (Amended) claims 3 and 8,** Apperson teaches that the client computer (i.e. a

terminal T) performs a step of verifying that each particular certificate's indicated authorized set

of privileges is a subset of the authorized set of privileges indicated in the digital certificate of

the next-higher member of the hierarchy that digitally signed the particular certificate, see col. 8,

line 65 through line 9 line 10.

Apperson further teaches a decision block indicating the action taken as a result of the

verification steps performed by the client computer which involves preventing the executable

code from exercising any privileges that are not in the requested set of privileges indicated by the

privilege request code, see col. 9, lines 11-29.

**As per (Amended) claim 7,** Apperson teaches that credentials associated with the

server computer or distributing authority include s privilege authorization code indicating which

privileges or privilege classes are allowed to be exercised by code distributed from server or

another distributing authority, see col. 4, lines 55-65. Apperson further teaches that the

credentials are issued to server or to the distributing authority by one or more certifying

authorities and are digitally signed by the certifying authorities and that the certifying authorities

are responsible for verifying the trustworthiness of the distributing authority (i.e. service

providers) and that the certifying authorities determine which privileges any particular

distributing authority should be allowed (or entitled) to authorize, see col. 4, line 66 through col.

6, line10.

**As per (Amended) claim 9,** Apperson's invention includes a first step of establishing a hierarchy of authorities comprising a plurality of certifying authorities and a plurality of distributing authorities (i.e. service providers) , see col. 7, lines 35-42. the members of the hierarchy are connected for communications over a network or other communications medium.

Apperson teaches assigning a privilege authorization code to each member of the hierarchy. The privilege authorization code indicates a set of privileges that a particular member (such as distributing authority or service provider) is authorized to incorporate in executable objects provided from one member for execution on other computers, see col. 7, lines 43-66, col. 8, lines 9-16. Apperson further teaches that the privilege authorization code indicates maximum set of privileges that member can include in the assigned privilege authorization codes of other, lower members of hierarchy.

Apperson teaches that the distributing authority (i.e. service provider) creates an executable code and optional data with a privilege request code associated wit the executable code. The privilege request code indicates a requested set of privileges that the executable code will potentially exercise on a client computer, see col. 8, lines 1-16. the requested set of privileges is a subset of the authorized set of privileges indicated the distributing authority's credentials.

### *Allowable Subject Matter*

Claims 12-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 4-6 are allowed over prior art of record.

## Examiner's Statement of Reason for Allowance

Prior art of record, *Apperson et al* teaches including in a certificate a definition of a predefined functionality . Prior art of record singly or in combination fails to teach or fairly suggests a definition of a predefined functionality comprising "definitions of wireless markup script language" , "definitions of wireless application protocol wireless telephoney application functions" and "definitions of wireless application protocol wireless markup language script standard functions" recited in independent claims 4-6.

## Response to Amendment

Applicant's arguments filed 2/12/2004 regarding the rejection of the claims 1-3, 7-11  under 35 U.S.C. 102() have been fully considered but they are not persuasive.

As per Applicant arguments relating to the rejections of claims 1-3, 7-11 , the Appliocant argues that "Apperson *et al*. fail to teach or suggest a service provider forwarding a request to a certifying authority for authorization, wherein the request comprises a definition of at least part of a global functionality supported in a telecommunication environment......................, including in the certificate a definition of the predefined functionality if the request is granted"

The Examiner disagrees.  Apperson teaches a system and method for distributing and executing an executable code (i.e. a predefined functionality) wherein before sending executable codes to a client (i.e. a terminal) , a distributing authority (i.e. a service provider) associates a privilege request code (i.e. predefined functionality) with the executable code, see abstract. The privilege request code indicates a requested set of privileges that the executable code will potentially exercise during execution.

Apperson teaches that the distributing authority digitally sign s the executable code and

the privilege request code, and also provides a certificate that can be traced by the client to a

known certifying authority (CA), see col. 2, lines 40-53. That is, Apperson's certificate can be

traced back to a known certifying authority. In other words, a distributing authority (i.e. a service

provider) must have forwarded a request to a certifying authority for a certificate (i.e. an

authorization)to have an executable code (i.e. a predefined functionality) be included in the

certificate prior to execution of the code.

Applicant argues that in Apperson et al., all the privilege request codes are already

incorporated into the certificates, and there is no disclosure of examination of individual

functionality requests from service providers, page 17, second paragraph.

The Examiner responds that "examination of individual functionality requests from

service providers" is not claimed in claim 1.

### Action is Final

**THIS ACTION IS FINAL.** Applicant is reminded of the extension of time policy as set forth in

37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR

1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

will the statutory period for reply expire later than SIX MONTHS from the mailing date of this

final action.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from examiner

should be directed to Taghi Arani, whose telephone number is (703) 305-4274. The examiner

can normally be reached Monday through Friday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Ayaz Sheikh, can be reached at (703) 305-9648. The Fax numbers for the

organization where this application is assigned is:

(703) 872-9306

Taghi Arani

Patent Examiner

May 11, 2004

AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100